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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,412	10/18/2001	Jan Bengtsson	AXISP702D1	3200
28436	7590	02/22/2005	EXAMINER	
IP CREATORS			ENG, DAVID Y	
P. O. BOX 2789			ART UNIT	
CUPERTINO, CA 95015			PAPER NUMBER	

2155

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/035,412	Applicant(s) BENGTSOON ET AL.	
	Examiner DAVID Y. ENG	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11 and 28-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11 and 28-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/162,681.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/02 & 5/03</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2155

A new title that is more aptly descriptive of the invention claimed is requested.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

A new abstract in compliance with the above is requested.

If applicant desires benefit of a previously filed application under 35 U.S.C. 120, specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence(s) of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. ____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition

Art Unit: 2155

should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

The preliminary amendment filed 10/18/2001 has been entered. Claims 1-10 and 12-27 have been cancelled. New claims 28-44 have been entered. The active claims are 11 and 28-44.

Applicants are requested to identify the support of 1. unique identifier uniquely identifying the IC, 2. non-unique network address and 3. unique network address (see claim 11) in the specification.

Applicants are further requested to identify the support of 1. the integrated circuit, 2. the memory (see claim 29), 3. the processor as described in claim 29 and 4. the cache controller in the drawings and the specification.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, and 28-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry (USP 5,778,180) in view of Johnson (USP 5,764,896).

See Figure 4 in Gentry. With respect to claims 11, 28, 29, 30, 32-35, Gentry taught:

an integrated circuit (NIC 12 in Figure 4) for coupling a peripheral device (50) with a network (media network 40) and the integrated circuit comprising:

Art Unit: 2155


a memory (any memory, buffer or latches in NIC, such as DMA 64, TX and RX FIFO); and

a processor (not shown, inherent within System and ATM Layer Core 22, see description of 22 in lines 25 et seq. of column 4) configured to couple to the network and the peripheral device, and the processor operable during an initialization mode to generate a unique identifier uniquely identifying the integrated circuit, to communicate across the network utilizing a non-unique network address together with the unique identifier to obtain both an operating system for the peripheral device and a unique network address (inherent function, all communication via network requires addresses), and to download (inherent, one of the main functions of connecting a peripheral device to a network is to download information including programs and multimedia data such as video and music, etc.) the operating system to the peripheral device via the memory thereby enabling a run-time mode for the peripheral device. Gentry does not explicitly show a processor within his NIC. Figure 3 of Johnson shows a processor inherently within a NIC. The NIC of Johnson also includes memory and other interfaces. From the teaching of Johnson, it would have been obvious to a person of ordinary skill in the art to implement System and ATM Layer Core 22 of Gentry with a processor for controlling the NIC. As to cache controller, both Gentry and Johnson taught a NIC having buffers or memory for buffering or caching data between network and peripheral via the NIC. The control for the buffers and memory within the NIC can be considered as cache controller. When the buffers and memory in active or inactive states can be considered as enabling or disabling the cache.

Art Unit: 2155

As to claims 31, 36, see the buses and data lines in the NIC of both Gentry and Johnson.

Claims 37- 44 do not recited above the invention defined in claims 11 and 28-36 and therefore are rejected for the same reasons.



DAVID T. ENG
PRIMARY EXAMINER